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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/239,873 01/29/99 LUHMAN

C LL11.12-0040

000164 HM12/0110
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EXAMINER

LEVY, N
ART UNIT

PAPER NUMBER

1616

DATE MAILED:

01/10/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/16/00

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-37 is/are pending in the application.

Of the above, claim(s) 5-7, 12, 15-27 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 8-11, 13, 14, & 28-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-37 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

BEST AVAILABLE COPY

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Receipt is acknowledged of amendment (4/10/01).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-7, 12, 15-27 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Claims 1, 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 09/338314. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 8-10, 29-32, 34-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record stands--only limited means are disclosed to provide production component effective enhancement

Claims 1, 9, 10, 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5503112. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims the instant method steps: feeding sugar alcohol; since up to 500 g are fed, some would get to the abomasum of instant claim 10 method.

Claims 1-3, 9-11, 13, 28, 33, 38-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Merensalmi-4127676.

The rejection of record is maintained.

The instant (claim 1) method constitutes the step of: providing a feed with sugar alcohol, and supplying to the abomasum. Merensalmi adds sugar alcohols to feed (lines 5-15, col. 2) and supplies to the abomasum--since the sugar alcohol is intact through the rumen (line 53-68; col. 2- lines 30-33, col. 3). Milk yield, therefore the components of the milk (unspecified) by applicant's claim) are increased (claim 1 of Merensalmi). Over 90% of the sugar alcohol is available to the abomasum, at 2 hours (col. 3, top, Example 1).

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Claims 1-4, 8-11, 13, 14, 28, 33, 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merensalmi in view of Baalsrud et al 3959493 and Remond et al '86 or Makinen et al '81 or Khalili et al '97.

The rejection of record is maintained, with embellishments. Merensalmi provides an active ingredient sugar alcohols, which need to get past the rumen (col. 1, line 57-line 11, col. 2); some degradation occurs (example 1). Baalsrud, and others provide rumor by pass means to deliver active substances. One of ordinary skill in the art of feeding dairy cows would find it obvious to use a by-pass form to deliver, intact, a desired nutrient, in order to most efficiently concentrate the required amount of nutrient sources within the limited capabilities of a high producing dairy cow to accept, in order to maximize production. Merensalmi points to this problem, in 1978. It's intensified now. Khalili, Makinen and Remono also show it was known t advantageously feed dairy cows sugar alcohols.

Applicant's arguments filed 4/10/01 have been fully considered but they are not persuasive. Applicants arguments and explanations have resulted in withdrawal of some rejections; however, the open language of claim 1 of supplying the sugar to the abomasum is seen as suggesting means beyond those presented in the specification. As to the restriction; it is maintained, as the methods of making, and the compositions, are required to be searched in areas over and above those pertaining to milk production, and constitute an unreasonable burden. As to the art rejections; Merensalmi does get sugar alcohols past the rumen, and does claim the instant benefits--this does

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not differ from applicant's invention. Further protection is an obvious advantage, and, other's also anew sugar alcohols enhanced production.

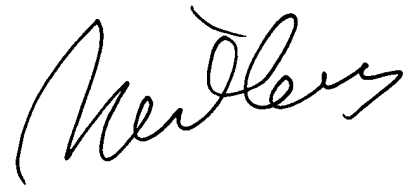
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday to Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy:mv

June 27, 2001



**NEIL S. LEVY
PRIMARY EXAMINER**